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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,070	12/13/2006	Roger C. Adami	PC25670A	5146

28523 7590 07/09/2009

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PATENT DEPARTMENT
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EXAMINER	
JAGOE, DONNA A	

ART UNIT	PAPER NUMBER
1614	

NOTIFICATION DATE	DELIVERY MODE
07/09/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

~IPGSGro@pfizer.com

Office Action Summary	Application No.	Applicant(s)	
	10/588,070	ADAMI ET AL.	
	Examiner	Art Unit	
	Donna Jagoe	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 March 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11,13-16,19,28 and 29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11,13-16,19,28 and 29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/23/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicants' arguments filed March 23, 2009 have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 11, 13-16, 19, 28 and 29 are pending in this application.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 29 and 30 have been renumbered 28 and 29.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11, 13-16, 19, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giles-Komar et al. U.S. Patent No. 7,163,681 B2 and Bronk et al. US

Patent Application Publication No. 2003/0139443 A1 and further in view of Ono et al. Eur. J. Pharm. Sci. 1999 (U).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Giles-Komar et al. teach a pharmaceutical composition comprising a β cyclodextrin such as 2-hydroxypropyl β cyclodextrin (column 43, lines 11-12) and other pharmaceutical excipients or additives that are suitable for use (column 43, lines 18-28) and further comprising a preservative such as m-cresol. (column 44, lines 24-35). Bronk et al. teach tachykinin antagonists (NK-1 receptor antagonists) encompassing formula (1a) R2 is *tert*-butyl (0099), and further comprising propylene glycol

(addressing instant claim 14) (paragraph 149 and 150) and sulfobutyl ether β cyclodextrin (see example 1, page 7, paragraph 163). Further, Bronk et al. teach that these NK-1 receptor antagonists can be administered parenterally (paragraphs 142 and 162).

It does not teach the compound of formula (1a) that is preserved with meta-cresol specifically. Giles-Komar et al. teach a β-cyclodextrin composition with an active agent that is preserved with m-cresol (meta-cresol) and Bronk et al. teach the specific compound in a cyclodextrin composition with a different preservative. Claim 19 is drawn to a specific amount of meta-cresol preservative in the β cyclodextrin composition and the specific binding value indicating the amount of preservative that is unsequestered. Ono et al. teach the formula by which one having ordinary skill in the art could readily calculate such binding values (see pages 135-136).

I would have been obvious to employ the composition of formula (1a) with a preservative such as m-cresol and a β cyclodextrin motivated by the teaching of Giles-Komar et al. who teaches a successful combination of β-cyclodextrin and m-cresol and Bronk et al. who discloses a formulation with the compound of formula (1a) combined with sulfobutyl ether β cyclodextrin and a preservative, armed with the formula of Ono to assure that the correct amount of β cyclodextrin is employed so as to prevent inclusion complexes and ensure solubility, stability and bioavailability (page 133, column 1). Addressing instant claim 29, methods of using the NK-1 receptor antagonists of formula 1a are disclosed in Bronk et al. for the treatment of vomiting (emesis) in companion animals such as dogs (paragraph 11), in view of the obviousness rejection supra.

Claim 28 is rejected because it is drawn to the pharmaceutical composition comprising about 10 mg/mL of a compound of Formula (1a), however, the claim fails to identify what is meant by formula (1a). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thus the claims fail to patentably distinguish over the state of the art as represented by the cited references.

Accordingly, for the above reasons, the claims are deemed properly rejected and none are allowed.

Response to Arguments

Applicant asserts that Giles-Komar does not provide any discussion relative to the complexation concerns relative to the use of cyclodextrins nor to the competitive inclusion complexation issues of a second compound e.g. antimicrobial preservative and therefore a skilled artisan could not easily ascertain the composition of the instant invention without undue experimentation. In response, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Bronk et al. teach the compound of formula (1a) and cyclodextrin, such as sulfobutyl ether β cyclodextrin, lacking the m-cresol preservative of instant claim 15. However Giles-Komar et al. teach a successful

combination of β-cyclodextrin and m-cresol and Ono teaches the method for determining the correct amount of β cyclodextrin employed so as to prevent inclusion complexes and ensure solubility, stability and bioavailability (page 133, column 1). Applicant asserts that Bronk et al. does not teach cyclodextrins. In response, cyclodextrins are disclosed in paragraph 163 (SBE cyclodextrin or sulfobutyl ether cyclodextrin) Bronk et al. further teach the NK-1 receptor antagonist for vomiting (emesis) (paragraph 11). The motivation to employ a cyclodextrin with m-cresol is provided by the teaching of Giles-Komar et al. who teach a successful combination of β-cyclodextrin and m-cresol and Ono who teaches the method for determining the correct amount of β cyclodextrin employed so as to prevent inclusion complexes and ensure solubility, stability and bioavailability.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna Jagoe whose telephone number is (571) 272-0576. The examiner can normally be reached on Monday through Friday from 8:00 A.M. - 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Donna Jagoe /D. J./
Examiner
Art Unit 1614

July 1, 2009

/Ardin Marschel/
Supervisory Patent Examiner, Art Unit 1614